

AMENDMENT UNDER 37 C.F.R. § 1.173  
U.S. Reissue Application No. 10/761,099

**REMARKS**

Upon entry of the claim amendments, Claims 1-81, 85-87, 92-97, and 99-128 will be all the claims pending in the application.

**I. CONCURRENT FILING OF INFORMATION DISCLOSURE STATEMENT**

Referring to Section No. 1 at page 2 of the Office Action, an Information Disclosure Statement is being concurrently submitted. See also the Notice of Interfering Subject Matter being filed concurrently and which discusses certain of the patents cited in the IDS. In view of the relative filing dates, Applicants submit that no basis exists to reject the present reissue claims over any of the patents discussed in the Notice.

**II. RESPONSE TO REJECTION UNDER 35 U.S.C. § 251 AND REJECTION UNDER 35 U.S.C. § 112**

Referring to Section No. 2 at pages 2 and 3 of the Office Action, Claims 49-75, 80-91, and 100-126 are rejected under 35 U.S.C. § 251 as being based upon new matter added to the patent for which reissue is sought. Also, referring to Section No. 6 at page 5 of the Office Action, Claims 49-75, 80-91, and 100-126 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Applicants respectfully traverse each of the rejections.

Of the presently rejected claims, Claims 49, 100, 104, 106, 110, 111, 115, 119, and 123 are independent. Each of the presently rejected independent claims has been amended to recite that layer (A) contains not less than 50% by weight of an aqueous alkali-soluble polymer compound containing, as a polymerization component, 10% by mol or more of a monomer effective to improve plate wear resistance and sensitivity. The “effective to improve plate wear resistance and sensitivity” recitation added to independent Claims 49, 100, 104, 106, 110, 111, 115, 119, and 123 finds literal support by the description at column 6, lines 6-20, of the ‘551 Patent.

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Further, the “necessary” language at column 6, line 6, noted by the examiner, falls within a discussion of the description of the preferred embodiments. *See*, column 3, line 50, of the ‘551 Patent. In such context, the term “necessary” is understood to mean “necessary to obtain the best result.” It was a mistake for Applicants to have limited the claims of the ‘551 Patent to preferred embodiments, and Applicants are correcting the mistake via, for example, independent Claims 49, 100, 104, 106, 110, 111, 115, 119, and 123.

Still further, the ‘551 Patent states at column 6, lines 20-23, that the “copolymer may include copolymerization components other than (a-1) to (a-3) monomer.” The statement at column 6, lines 20-23, is understood to mean that the subsequently listed monomers, including categories (1) to (12), are alternatives to, and not optional supplements to, monomers (a-1) to (a-3).

Applicants turn now to the recitations in independent Claims 100, 104, 106, 110, 111, 115, 119, and 123 that at least one of layer (A) and layer (B) comprises at least one compound which generates heat upon absorbing light.

The “necessary” language at column 16, line 66, through column 17, line 1, noted by the examiner, falls within a discussion of the description of the preferred embodiments. *See*, column 3, line 50, of the ‘551 Patent. In such context, the term “necessary” is understood to mean “necessary to obtain the best result.” It was a mistake for Applicants to have limited the claims of the ‘551 Patent to preferred embodiments, and Applicants are correcting the mistake via, for example, independent Claims 100, 104, 106, 110, 111, 115, 119, and 123. Indeed, a functioning positive-type photosensitive image-forming material is provided regardless of whether the at least one compound which generates heat upon absorbing light is present in layer (A) or layer (B), so long as it is present in the positive-type photosensitive image-forming material.

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the present §251 rejection and the present §112 rejection.

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**III. RESPONSE TO REJECTION UNDER 35 U.S.C. § 251**

Referring to Section No. 3 at pages 3 and 4 of the Office Action, Claims 100-122 are rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Applicants respectfully traverse.

Of the presently rejected claims, Claims 100, 104, 106, 110, 111, 115, 119, and 123 are independent. Each of the presently rejected independent claims has been amended to recite that layer (B) is laminated directly on the layer (A) formed on the substrate.

For the foregoing reason, Applicants respectfully request reconsideration and withdrawal of the present §251 rejection.

**IV. RESPONSE TO REJECTION UNDER 35 U.S.C. § 112**

Referring to Section No. 4 at page 4 of the Office Action, Claims 90 and 91 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Applicants respectfully traverse.

Claims 90 and 91 have been canceled, rendering moot the present §112 rejection.

In addition, allowed Claim 44 has been amended to recite that at least layer (A) contains an oil-soluble dye or basic dye which is capable of substantially lowering the solubility of the aqueous alkali-soluble polymer compound and is selected from the particular group of dyes recited therein.

For the foregoing reason, Applicants respectfully request reconsideration and withdrawal of the present §112 rejection.

**V. RESPONSE TO REJECTION UNDER 35 U.S.C. § 112**

Referring to Section No. 5 at page 5 of the Office Action, Claims 92-97 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Applicants respectfully traverse.

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Of the presently rejected claims, Claim 92 is independent. Applicants have incorporated the subject matter of Claim 98 into Claim 92. Accordingly, amended Claim 92 recites that the negative image-forming material further contains in at least one of layers (A) and (B) a material which crosslinks in the presence of an acid.

For the foregoing reason, Applicants respectfully request reconsideration and withdrawal of the present §112 rejection.

**VI. RESPONSE TO REJECTION UNDER 35 U.S.C. § 102**

Referring to Section No. 7 at page 6 of the Office Action, Claims 49-50, 53-55, 80-82, 85-88, 100-101, 111-112, 115-116, 119-120, and 123-124 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,922,502 (“Damme ‘502”).

Applicants respectfully traverse.

Damme ‘502 does not disclose each and every element of the presently rejected claims.

For example, of the presently rejected claims, Claims 49, 100, 111, 115, 119, and 123 are independent. Each of the presently rejected independent claims recites that layer (A) contains not less than 50% by weight of an aqueous alkali-soluble polymer compound containing, as a polymerization component, 10% by mol or more of a monomer effective to improve plate wear resistance and sensitivity. Damme ‘502 does not disclose a positive type photosensitive image-forming material having the presently claimed features, including a layer corresponding to presently claimed layer (A).

In addition, dependent Claims 80-81 are separately patentable for at least the following reason. Claim 80 (Claim 81 depends from Claim 80) recites that layer (B) further contains a cyanine dye and at least one onium salt. Damme ‘502 does not disclose a positive type photosensitive image-forming material having the features of Claims 80 and 81, including a layer corresponding to presently claimed layer (B).

For at least the foregoing reasons, Applicants request reconsideration and withdrawal of the present §102 rejection.

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**VII. RESPONSE TO REJECTION UNDER 35 U.S.C. § 103**

Referring to Section No. 8 at page 7 of the Office Action, Claims 51-52, 56-76, 83-84, 90-91, 102-105, 110, 113, 117-118, 121, and 125-126 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Damme ‘502 in view of U.S. Patent No. 5,731,123 (“Kawamura”) and U.S. Patent No. 6,280,899 (“Parsons”).

Applicants respectfully traverse.

As an initial matter, Claim 76 appears to have been inadvertently included in the present rejection. The examiner stated at Section No. 11 on page 8 of the Office Action that Claim 76 contains allowable subject matter.

Each of presently rejected Claims 51-52, 56-76, 83-84, 90-91, 102-103, 113, 117-118, 121, and 125-126 is a dependent claim which depends from an independent claim included in the §102 rejection over Damme ‘502 responded to at Section VI above. Presently rejected Claims 104 and 110 are independent claims including the recitation that layer (A) contains not less than 50% by weight of an aqueous alkali-soluble polymer compound containing, as a polymerization component, 10% by mol or more of a monomer effective to improve plate wear resistance and sensitivity. As for presently rejected Claim 105, it depends from Claim 104.

Therefore, each of the presently rejected claims is not disclosed or suggested by Damme ‘502 for the same reasons set forth at Section VI above.

Kawamura and Parsons do not cure the deficiencies of Damme ‘502 noted at Section VI above. For example, Parsons teaches “an additional layer disposed beneath the oleophilic, heat-sensitive composition, wherein the additional layer comprises a radiation absorbing compound.” See, column 4, lines 30-33, of Parsons. Parsons does not specifically teach a layer corresponding to claimed layer (A) containing not less than 50% by weight of an aqueous alkali-soluble polymer compound containing, as a polymerization component, 10% by mol or more of a monomer effective to improve plate wear resistance and sensitivity. Indeed, the examiner merely relies on Kawamura and Parsons for their teachings of dyes.

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For at least the foregoing reasons, Applicants request reconsideration and withdrawal of the present §103 rejection.

**VIII. RESPONSE TO REJECTION UNDER 35 U.S.C. § 102**

Referring to Section No. 9 at page 8 of the Office Action, Claims 49-50, 53-54, 58-61, and 64-67 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,060,222 ("West").

Applicants respectfully traverse.

West does not disclose each and every element of the presently rejected claims.

For example, of the presently rejected claims, Claim 49 is independent. Claim 49 recites that layer (A) contains not less than 50% by weight of an aqueous alkali-soluble polymer compound containing, as a polymerization component, 10% by mol or more of a monomer effective to improve plate wear resistance and sensitivity. West does not disclose a positive type photosensitive image-forming material having the presently claimed features, including a layer corresponding to presently claimed layer (A).

For at least the foregoing reasons, Applicants request reconsideration and withdrawal of the present §102 rejection.

**IX. RESPONSE TO REJECTION UNDER 35 U.S.C. § 102**

Referring to Section No. 10 at page 8 of the Office Action, Claims 49-75, 85-91, 104-109, 111-114, and 119-126 are rejected under 35 U.S.C. § 102(e) as being anticipated by Parsons.

Applicants respectfully traverse.

Parsons does not disclose each and every element of the presently rejected claims.

For example, of the presently rejected claims, Claims 49, 104, 106, 111, 119, and 123 are independent. Each of the presently rejected independent claims recites that layer (A) contains not less than 50% by weight of an aqueous alkali-soluble polymer compound containing, as a

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polymerization component, 10% by mol or more of a monomer effective to improve plate wear resistance and sensitivity. Parsons discloses “an additional layer disposed beneath the oleophilic, heat-sensitive composition, wherein the additional layer comprises a radiation absorbing compound.” See, column 4, lines 30-33, of Parsons. Parsons does not disclose a layer corresponding to claimed layer (A) containing not less than 50% by weight of an aqueous alkali-soluble polymer compound containing, as a polymerization component, 10% by mol or more of a monomer effective to improve plate wear resistance and sensitivity.

For at least the foregoing reasons, Applicants request reconsideration and withdrawal of the present §102 rejection.

**X. ALLOWED AND ALLOWABLE CLAIMS**

Applicants note with appreciation the examiner’s indication at Section No. 11 on page 8 of the Office Action that Claims 1-48 are allowed.

Applicants also thank the examiner for indicating that Claims 76-79 and 97-98 would be allowable if rewritten in independent form, including all of the recitations of the base claim and any intervening claims. Applicants have rewritten Claim 76 as an independent claim and incorporated the subject matter of Claim 98 into Claim 92. Accordingly, Applicants request an indication that Claims 76-81 (each of Claims 77-81 depends from Claim 76) and Claims 92-97 (each of Claims 93-97 depends from Claim 92) are allowed in the next communication to Applicants.

**XI. CONCLUSION**

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the examiner feels may be best resolved through a personal or telephone interview, the examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

*Kenneth Burchfield*  
Reg No 31,333

*for* Mark Boland  
Registration No. 32,197

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

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